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CONFIRMATION NO. FIRST NAMED INVENTOR ATTORNEY DOCKET NO. APPLICATION NO. FILING DATE PNX1P004 7286 03/22/2001 Allen R. DeCotiis 09/815,985 **EXAMINER** 10/19/2004 HEWITT II, CALVIN L C. DOUGLAS MCDONALD, ESQ CARTON FIELDS, ET AL. PAPER NUMBER ART UNIT P.O. BOX 3239 TAMPA, FL 33601-3239 3621

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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	Application No.	Applicant(s)
Office Action Summary	09/815,985	DECOTIIS ET AL.
	Examiner	Art Unit
·	Calvin L Hewitt II	3621
The MAILING DATE of this communication Period for Reply	appears on the cover sheet w	ith the correspondence address
A SHORTENED STATUTORY PERIOD FOR RE THE MAILING DATE OF THIS COMMUNICATIO - Extensions of time may be available under the provisions of 37 CFF after SIX (6) MONTHS from the mailing date of this communication - If the period for reply specified above is less than thirty (30) days, a - If NO period for reply is specified above, the maximum statutory pe - Failure to reply within the set or extended period for reply will, by st Any reply received by the Office later than three months after the m earned patent term adjustment. See 37 CFR 1.704(b).	N. R 1.136(a). In no event, however, may a description of the statutory minimum of thir rich will apply and will expire SIX (6) MON atute, cause the application to become Al	reply be timely filed by (30) days will be considered timely. ITHS from the mailing date of this communication. BANDONED (35 U.S.C. § 133).
Status		,
1) Responsive to communication(s) filed on 2	2 March 2001.	
a) ☐ This action is FINAL . 2b) ☑ This action is non-final.		
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is		
closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.		
Disposition of Claims		
4)⊠ Claim(s) <u>1-18</u> is/are pending in the application.		
4a) Of the above claim(s) is/are withdrawn from consideration.		
5) Claim(s) is/are allowed.		
6)⊠ Claim(s) <u>1-18</u> is/are rejected.		
7) Claim(s) is/are objected to.		
8) Claim(s) are subject to restriction an	d/or election requirement.	
Application Papers		
9)☐ The specification is objected to by the Examiner.		
10) The drawing(s) filed on is/are: a) □ accepted or b) □ objected to by the Examiner.		
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).		
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).		
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.		
Priority under 35 U.S.C. § 119		
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:		
1. Certified copies of the priority documents have been received.		
2. Certified copies of the priority documents have been received in Application No		
3. Copies of the certified copies of the priority documents have been received in this National Stage		
application from the International Bureau (PCT Rule 17.2(a)).		
* See the attached detailed Office action for a list of the certified copies not received.		
Attachment(s)		
1) Notice of References Cited (PTO-892)	4) Interview S	Summary (PTO-413)
2) 🔲 Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s	s)/Mail Date
 Information Disclosure Statement(s) (PTO-1449 or PTO/SB/ Paper No(s)/Mail Date <u>2-25-02</u>. 	(08) 5) Notice of Ir 6) Other:	nformal Patent Application (PTO-152)

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Status of Claims

1. Claims 1-18 have been examined.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

 Claims 1-18 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The Applicant's claimed invention does not fall within the technological arts because no form of technology is disclosed or claimed, hence, the claimed invention does not promote the progress of science and the useful arts. Claim 1 is merely an abstract idea (e.g. a mathematical formula) as it is not tied to the computer arts. Claim 7 recites "computer code", while claim 13 recites "logic". However, the computer code is not stored on a computer readable medium and the "logic" is not embedded in a computer, for example, that is used to implement the claimed system. Similarly, claims 5, 11 and 17 recite "database", but a database can be a book, or written on a piece of paper, and therefore computer implementation is not inherent by the mere use of the term "database". Also, the "usefulness" of claims 1, 7 and 13 is not apparent. Specifically, the outcome of

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the Applicant's claimed processing is a number without a practical application, and was produced without transformation of the data by a machine, such as a computer. Hence the claimed invention does not produce useful, concrete and tangible result (*State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998)).

Claim Rejections - 35 USC § 112

- 4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

 The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
- 5. Claims 3, 4, 9, 10, 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3, 9, and 15 recite "the list" in line 2. Claims 4, 10, and 15 recite the limitation "the list" and "the same" in line 2. There is insufficient antecedent basis for the limitation ("the same", "the list") in the claims.

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Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Rothman et al., U.S. Patent No. 6,505,168.

As per claims 1-18, Rothman et al. teach system for using a weighted model comprising:

- creating a model, calculating a score for a plurality of individuals based on survey information wherein the score indicates a propensity to have a particular attitude, behavior or demographic (abstract; figures 5 and 6; column/line 2/65-3/5)
- a model that sets forth a plurality of characteristics and a weight (i.e. equal) of each of the characteristics for calculating the score (column 4, lines 35-55; column 5, lines 38-64)

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 sorting (i.e. compiling) and ranking the individuals (on a list) based on the score (abstract; figures 5 and 6; column/line 6/66-7/20)

creating a model using [credit card] information stored in a database
 (figure 5; column 10, lines 48-55)

Conclusion

- 8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:
 - Suzuki et al. teach a system for generating offers based on user purchase history
 - Smolen teaches collecting customer information using surveys
- 9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

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c/o Technology Center 2100

Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.